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In re Application of

SHIBATA, et al.

Serial No.: 10/019,282

PCT No.: PCT/JP00/04285

Int. Filing Date: 28 June 2000

Priority Date: 02 July 1999

Atty. Docket No.: 217770USOPCT

For: GENE ENCODING CYCLIC
LIPOPEPTIDE ACYLASE AND
EXPRESSION OF THE SAME

DECISION

This is a response to applicants' "Petition under 37 CFR 1.181 to Withdraw Holding of Abandonment" filed 23 February 2004. No petition fee is required.

BACKGROUND

On 28 June 2000, applicants filed international application no. PCT/JP00/04285 which claimed a priority date of 02 July 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 January 2001. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 02 January 2002.

On 02 January 2002, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application; and 32 pages of sequence listing.

On 19 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating declaration in compliance with 37 CFR 1.497(a) and (b) was required. Furthermore, the Notification stated that the sequence listing was not in compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in computer readable form had not been submitted as required by 37 CFR 1.821(e).

On 11 April 2002, applicants filed a declaration and power of attorney.

On 12 December 2003, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 19 March 2002 within the time period set therein.

On 23 February 2004, applicants filed the present petition to withdraw holding of abandonment which included a copy of the declaration and return postcard receipt submitted on 11 April 2002.

DISCUSSION

The above-identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 19 March 2002, in that, the sequence listing in computer readable form had not been submitted within the period set therein. A review of the application file reveals that the only the paper copy of sequence listing has been submitted.

37 CFR 1.821(e) states:

A copy of the "Sequence Listing" referred to in paragraph (c) of this section must also be submitted in computer readable form in accordance with the requirements of § 1.824. The computer readable form is a copy of the "Sequence Listing" and will not necessarily be retained as a part of the patent application file. If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Patent and Trademark Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application if the computer readable form in the other application was compliant with all of the requirements of these rules. The new application shall be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified. In the new application, applicant must also request the use of the compliant computer readable "Sequence Listing" that is already on file for the other application and must state that the paper copy of the "Sequence Listing" in the new application is identical to the computer readable copy filed for the other application.

As stated above, the filing the paper copy of the "Sequence Listing" does not satisfy the requirements of 37 CFR 1.825(e) and the application was abandoned for failure to respond to the Notification of Missing Requirements dated 19 March 2002. However, upon receipt of the declaration dated 11 April 2002, in response to the Notification of Missing Requirements, the United States Patent and Trademark Office should have mailed a Notification of Defective Response indicating that the sequence listing and sequence listing in computer readable form were still required. Since the Patent and Trademark Office erred in not mailing this form to applicants, the Notification of Abandonment was mailed in error

and is hereby withdrawn. Therefore, applicants' petition to withdraw holding of abandonment is granted.

CONCLUSION

Therefore, the petition to withdraw holding of abandonment is **GRANTED**.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that a sequence listing in compliance with 37 CFR 1.821 -1.825 is required.



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